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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,315	08/31/2001	Martin W. Masters	2001P16281US	2177

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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DABNEY, PHYLESHA LARVINIA

ART UNIT	PAPER NUMBER
2643	70

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/944,315

Applicant(s)

MASTERS ET AL

Examiner

Phylesha L Dabney

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: (see attached).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-19.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

  
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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 800

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

This action is in response to the request for reconsideration filed on 02 March 2004 in which claims 1-19 are pending.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-6, 8-9, 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Widmer et al (U.S. Patent No. 6,401,859).

Regarding claims 1 and 13, Widmer teaches a textured hearing instrument shell (figs. 4-24).

Regarding claim 2, Widmer teaches a hearing instrument comprising a textured outer surface portion, wherein the portion is inserted in the ear of a user (figs. 4-24).

Regarding claim 3, Widmer teaches the hearing instrument texture is non-smooth (figs. 4-10).

Regarding claim 5, Widmer teaches the texture comprises a series of lines, unequally spaced (figs. 7-10).

Regarding claim 6, Widmer teaches the texture comprises a predetermined or randomly generated pattern (figs. 9-10, 13-14).

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Regarding claims 8-9 and 11-12, see the rejections of claims 2-6 respectively.

Regarding claim 14, Widmer teaches a hearing instrument comprising a textured outer surface portion made by a process comprising laser (col. 3 line 60 through col. 4 line 34).

Regarding claim 15, Widmer teaches a hearing instrument comprising an outer surface fabricated as a series of layers, and a textured outer surface portion made by a process comprising applying a waveform (laser application, col. 3 line 60 through col. 4 line 34) to the edges of one or more of the layers during the fabrication process (claim 3).

Regarding claim 16, Widmer teaches a hearing instrument comprising an outer textured surface made by a process comprising: a mold cavity fabrication derived from surface contours of user's ear (col. 14 line 64 through col. 16 line 4); and modifying the mold cavity to create texture in the outer surface (col. 3 line 60 through col. 4 line 34).

Regarding claims 17-18, see the rejection of claims 2-6, 14, and 15.

Regarding claim 19, see the rejection of claims 2-6, and 16.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widmer (U.S. Patent No. 6,401,859).

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Regarding claims 4 and 10, Widmer does not teach or restrict the finish applied to the hearing instrument. Furthermore, the examiner takes official notice that it is known for hearing instruments to be made with a variety of finishes, such as non-reflective, reflective, glow-in-the-dark, neon, glossy, etc. for aesthetic appeal to the hearing aid wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the hearing aid with any of a variety of finishes for aesthetic desirability to the user.

Regarding claim 7, Widmer does not teach incorporating a faceplate onto the hearing instrument (figs. 4-23) comprising a textured outer surface; however, the examiner takes official notice that it is known to include a textured faceplate onto a hearing instrument for housing external components such as volume control, battery, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a faceplate onto the hearing aid instrument for housing external components.

#### ***Response to Amendment***

The affidavit under 37 CFR 1.132 filed 2 March 2004 is insufficient to overcome the rejection of claims 1-19 based upon Widmer (U.S. Patent No. 6,401,859) applied under 35 U.S.C. 102(e) and 35 U.S.C 103(a) as set forth in the last Office action because: see the response to arguments below.

#### ***Response to Arguments***

**Applicant's amendment is also improper. All amendment to the specification, claims, etc., must follow the guidelines listed on last three pages.**

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With respect to the applicant's arguments that *the Widmer reference does not disclose, teach or suggest a textured surface, the examiner disagrees with this statement.*

The Manual of Patent Examination Practice clearly defines the way to properly interpret a term presented in a claim as such: (MPEP 2111.01 [R-1]) The words of a claim must be given "plain meaning" unless they are defined in the specification. While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning **unless applicant has provided a clear definition in the Specification**. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); MSM Investments Co. v. Carolwood Corp., 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001) One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

"Plain meaning" refers to the meaning given to the term by those of ordinary skill in the art. **When not defined by applicant in the specification, the words of a claim must be given their plain meaning.** In other words, they must be read as they would be interpreted by those of ordinary skill in the art. Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms); Toro Co. v. White

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Consol. Indus., Inc., 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999).

In this instance, the applicant defines a textured surface in his specification on pages 2 and 5.

Excerpt page 2, *"By creating a textured, non-smooth finish on the outer shell of a hearing instrument, the hearing instrument will more readily lodge and remain within the ear canal. Furthermore, the textured finish has an appearance closer to that of natural skin and therefore, the hearing instrument is less noticeable to others, blending in with the visible portions of the ear."*

Excerpt page 5, *"A variety of textures may be utilized with hearing instrument shells. The texture may be a series of lines..., equally or unequally spaced..., or a plurality of shapes (e.g. ovals and circles...), or some other pattern, predetermined or randomly generated."*

The applicant's specification teaches that the finish, or outward aesthetic appeal, has an "appearance" of natural skin for the purpose of blending in with the visible portion of the ear which is not included in the claim language. The texture, or surface composition, of the hearing shell is composed of a series of lines, shapes, and/or etc., on the surface. The Widmer reference clearly supports this limitation and the definition presented in the specification by the applicant

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(figures 4-24, column 6 lines 13-22, and the multiple channel configurations outlined and taught in the patent).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L Dabney whose telephone number is 703-306-5415. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314, for formal communications intended for entry and for informal or draft communications, please label "Proposed" or "Draft" when submitting an informal amendment.

(703) 306-0377, for customer service questions.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

PLD



March 9, 2004



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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2000

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Serial Number

- \_\_\_ Canceled claims cannot show text of claim.
- \_\_\_ "Amended" is not a proper status identifier.
- \_\_\_ Amendments to the Specifications should begin on a separate page.
- \_\_\_ Amendment to the Claims should begin on a separate page.
- \_\_\_ "Remarks" should begin on a separate sheet.
- \_\_\_ The "Cover Sheet", amendments to the "Specifications", amendments to the "Claims", and "Remarks" should each begin on a separate sheet.
- \_\_\_ Only "Currently Amended" and "Withdrawn" claims can show markings.
- \_\_\_ Drawings should each have "Replacement Sheet(s)" or "Annotated Sheet(s)" as a heading.
- \_\_\_ "Previously Added" is not a proper status identifier.
- \_\_\_ "Previously Amended" is not a proper status identifier.
- \_\_\_ A Clean copy and A Marked Up copy of the Claims is a Non-Compliant amendment Format.
- \_\_\_ "Re-Presented" is an improper status identifier.
- \_\_\_ "Claims \_\_\_\_\_ have been cancelled" is an improper status identifier.
- \_\_\_ "Currently Amended claims must show markings.

\_\_\_\_ A Clean copy and a Marked Up copy of Substitute Specification is needed.

\_\_\_\_ Amendments to the Specifications must be by marked-up replacement paragraphs or sections only; (no clean or replacement paragraph or section is required; No replacements sheets permitted.

\_\_\_\_ \_\_\_\_\_  
\_\_\_\_\_

## REVISED AMENDMENT PRACTICE HIGHLIGHTS

Requirements of the revised amendment practice of the final rule for all amendments filed on or after July 30, 2003 :

1. Each amendment section must begin on a separate sheet
2. A separate "clean" version of a currently amended paragraph or claim is **NO LONGER REQUIRED** (except for a substitute specification – see No. 5 below)
3. If the amendment adds, changes, or deletes any claim, a listing of all claims that are, or were, in the application, must be provided as follows:
  - The claims must be listed in ascending numerical order
  - The text of all pending claims including withdrawn claims must be presented; no text for "canceled" or "not entered" claims
  - A status identifier must be presented in parentheses after the claim number for each claim; only the following identifiers are permitted: (original), (currently amended), (canceled), (withdrawn), (new), (previously presented), and (not entered)
  - All "currently amended" claims must have markings to show changes; the only markings permitted are underlining for added matter, strikethrough and double brackets [[ ]] (for five or fewer characters) for deleted matter
  - Grouping of consecutive "canceled" or "not entered" claims permitted (e.g., claims 2-8 (canceled))
5. Amendments to the specification by marked-up replacement paragraphs or sections only - no clean replacement paragraph or section is required; **NO** replacement sheets permitted
  - Note, however, that for substitute specifications, rule 1.125 continues to require both a clean and marked-up copy
6. Drawing changes without markings - clean replacement drawing sheets only – annotated sheet(s) showing changes may be submitted